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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/873,542 | 06/04/2001 | John Denton Biddle | 37554.0200 | 7586 |

20322 7590 09/22/2005

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| EXAMINER |
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OUELLETTE, JONATHAN P

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,542

Applicant(s)

BIDDLE ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20010820, 20020311</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 53 and 54 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-52 and 55-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Doherty et al. (US 6,920,567 B1).**
4. As per **independent Claims 1 and 21**, Doherty discloses a method for managing licensing data, comprising the steps of: providing a host system having a processor for processing digital data; providing a client system having a processor for processing digital data and communicably connected to said host system; providing a license management host application running on said host system, said host application having access to a licensing database; providing a license management client application running on said client system,

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said client application having access to a client license datastore (Figs. 1-4); providing a user interface configured to accept licensing orders, said user interface providing a user with access for ordering a license, said user interface requesting the issuance of a license; issuing a license from said licensing database, using said management host application, in response to a user interface request to add a license to said client license datastore; monitoring usage of a license so issued using said management host application; compiling and displaying at least a plurality of licenses stored in said client license datastore using said license management client application; and communicating with said host application, using said license management client application to modify terms corresponding to at least one license stored in said client license datastore (Figs. 1-4, C9-C14, and Claims 1-15).

5. As per Claims 2 and 22, Doherty discloses wherein said host application is administered by at least one of a vendor, a distributor, an agent, a manager, a reseller, a value-added reseller (VAR), a contractor, a sub-contractor, a subsidiary, a partner, an Original Equipment Manufacturing (OEM) provider, a licensee, a sub-licensee, a trustee, and a fiduciary.
6. As per Claim 3, Doherty discloses wherein said communicable connection between said client system and said server system is selected from the group consisting of a LAN, a WAN, a VPN, the Internet, an extranet, an intranet, and any combination thereof.
7. As per Claim 4, Doherty discloses wherein said licensing database is at least one of an ADO compliant database, an ODBC database, a relational database, a flat file, and an SQL compatible database.
8. As per Claim 5, Doherty discloses populating said database with default structure.
9. As per Claim 6, Doherty discloses populating said database with default data.

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10. As per Claim 7, Doherty discloses wherein said population of said database comprises licensing terms.
11. As per Claim 8, Doherty discloses wherein said datastore is encrypted.
12. As per Claim 9, Doherty discloses wherein said datastore is stored locally on the client system.
13. As per Claim 10, Doherty discloses wherein said datastore is hosted from a remote location.
14. As per Claim 11, Doherty discloses wherein a license issued by said host application is at least one of a trial license, a time-limited license, a perpetual license, a subscription-based license, and an irrevocable license.
15. As per Claim 12, Doherty discloses wherein said client application uses a graphic user interface (GUI) for compiling at least a plurality of licenses stored in said client license datastore.
16. As per Claim 13, Doherty discloses wherein said GUI further comprises a native file management application component of said client system's operating system.
17. As per Claim 14, Doherty discloses wherein said modification of the terms corresponding to at least one license stored in said client license datastore further comprises a method step selected from the group consisting of deleting a license, expiring a license, terminating a license, renewing a license, manually subscribing a license, automatically subscribing a license, transferring a license, abandoning a license, reactivating a license, and any combination thereof.
18. As per Claim 15, Doherty discloses wherein said license management host application further comprises at least one of a Terminate and Stay Resident program (TSR), an operating

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system service, a daemon, a stand-alone application, an applet, a protected mode application, a multi-threaded application, a parallel processed application, and a distributed processing application.

19. As per Claim 16, Doherty discloses wherein said host application monitoring of usage of a license further comprises a method step selected from the group consisting of collecting machine identification data, collecting user identification data, tracking time of use data, tracking duration of use data, sending a cookie from said client system to said host system, and any combination thereof.
20. As per Claim 17, Doherty discloses the licensing of a software application.
21. As per Claim 18, Doherty discloses wherein said client system further comprises at least one of a computer, a kiosk, a web access portal, a Point of Sale (POS) terminal, a smartcard, a wireless transmitter, a portable digital assistant, a telephone, a mobile phone, a pager, and an information appliance.
22. As per Claim 19, Doherty discloses wherein said host application further comprises tools to customize the licensing database.
23. As per Claim 20, Doherty discloses wherein said user interface for accepting licensing orders further comprises media adapted for display on a web browser.
24. As per Claim 23, Doherty discloses wherein said vendor is also a distributor.
25. As per **independent Claim 24**, Doherty discloses a method for managing the licensing of software, comprising the steps of: providing a host system having a processor for processing digital data; providing a client system having a processor for processing digital data and communicably connected to said host system; providing a license management host

application running on said host system, said host application having access to a licensing database (Figs. 1-4); providing a software application to be licensed; providing a substantially turnkey wrapping utility for securing compiled instruction code and wrapping said software application with licensing security code (C5-C6); providing a license management client application running on said client system, said client application having access to a client license datastore; providing a user interface configured to accept licensing orders, said user interface providing a user with substantially self-service access for ordering a license, said user interface requesting the issuance of a license; issuing a license from said licensing database, using said management host application, in response to a user interface request to add a license to said client license datastore; monitoring usage of a license so issued using said management host application; compiling and displaying at least a plurality of licenses stored in said client license datastore using said license management client application; and communicating with said host application, using said license management client application to modify terms corresponding to at least one license stored in said client license datastore (Figs. 1-4, C9-C14, and Claims 1-15).

26. As per Claim 25, Doherty discloses the step of said host service providing means for downloading said wrapped application.
27. As per Claim 26, Doherty discloses providing means for purchasing a license from said host service; and processing payment for said purchase of a license.
28. As per Claim 27, Doherty discloses wherein said host application further comprises tools to customize the licensing database.

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29. As per Claim 28, Doherty discloses wherein said host application further comprises tools to customize the wrapping of said software application.
30. As per Claim 29, Doherty discloses encrypting said wrapped application.
31. As per Claim 30, Doherty discloses obtaining information from a user of the license management client application to authorize access to execute said wrapped application.
32. As per Claim 31, Doherty discloses downloading said wrapped application over a communications network.
33. As per Claim 32, Doherty discloses the distribution of wrapped vendor/developer software applications by a distributor.
34. As per Claim 33, Doherty discloses wherein the distributor is also the vendor/developer.
35. As per Claim 34, Doherty discloses offering user-selectable software options for the wrapped application before issuing a license to execute the wrapped application.
36. As per Claim 35, Doherty discloses providing tools to customize the functionality of said license management host application.
37. As per Claim 36, Doherty discloses providing tools to customize the functionality of said license management client application.
38. As per Claim 37, Doherty discloses providing tools to customize the distributor-created licensing code.
39. As per **independent Claim 38**, Doherty discloses a method for protecting software from unlicensed use, comprising the steps of: providing turnkey licensing code to vendors for wrapping a vendor-provided software application; encrypting said vendor-provided software

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application; wrapping distributor licensing code around said vendor-provided software application (Figs. 1-4, C5-C6, C9-C14, and Claims 1-15).

40. As per Claim 39, Doherty discloses wherein said vendor is also a distributor.
41. As per Claim 40, Doherty discloses wherein the wrapped code produced in the preceding iteration is further wrapped to produce at least a second-generation wrapped executable application.
42. As per Claim 41, Doherty discloses wherein the distributor code is compiled substantially concurrent with compilation of said vendor-provided software.
43. As per Claim 42, Doherty discloses wherein vendor-provided startup code is replaced with distributor-provided startup code.
44. As per Claim 43, Doherty discloses using the distributor-provided startup code as a decryption key.
45. As per Claim 44, Doherty discloses executing said wrapped application, wherein the wrapped software application begins execution at a substantially random codebase offset entry point.
46. As per Claim 45, Doherty discloses calculating a CRC for the wrapped application at least prior to execution of said wrapped application to determine if the wrapped application has been modified.
47. As per Claim 46, Doherty discloses disabling execution of said wrapped application if said wrapped application has been determined to have been modified.
48. As per Claim 47, Doherty discloses monitoring execution of said wrapped application to determine if tampering attempts to said wrapped application are being made.

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49. As per Claim 48, Doherty discloses terminating execution of said wrapped application in response to said tampering attempts.
50. As per Claim 49, Doherty discloses obtaining information from the user to validate licensing information and to permit execution of said wrapped application.
51. As per Claim 50, Doherty discloses calculating a machine fingerprint for comparison with licensing information to authorize execution of said wrapped application.
52. As per Claim 51, Doherty discloses providing a license on a subscription basis.
53. As per Claim 52, Doherty discloses automatically renewing said license subscription.
54. As per Claim 53 as understood by the Examiner, Doherty discloses providing a distributor with a system for managing licensing data.
55. As per Claim 54 as understood by the Examiner, Doherty discloses providing a vendor/developer with system for managing licensing data.
56. As per Claim 55, Doherty discloses wherein the vendor/developer is also the distributor.
57. As per **independent Claim 56**, Doherty discloses a system for providing substantially self-serviced access in a network environment to a plurality of vendor-provided software applications for electronic distribution to a remote user, said system comprising: means for providing at least a plurality of software applications for distribution; means for electronically distributing at least one software application (Figs. 1-4); means for protecting at least one software application so distributed from unlicensed access; means for storing license files in a licensing database; means for issuing a license from said licensing database to said remote user; and means for modifying the terms of the issued license, thereby

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allowing said system to provide substantially self-service electronic distribution from the perspective of said remote user (Figs. 1-4, C9-C14, and Claims 1-15).

58. As per Claim 57, Doherty discloses means for said remote user to select optional software features.

59. As per Claim 58, Doherty discloses wherein said means for providing at least a plurality of software applications for distribution comprises a web-based storefront.

60. As per Claim 59, Doherty discloses wherein said issued license is a subscription-based license.

61. As per Claim 60, Doherty discloses wherein said means for modifying said license comprises an automatic renewal of said license.

Conclusion

62. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

63. The following foreign patent is cited to show the best foreign prior art found by the examiner:

PCT No. WO 9601550 A1 to GRISWOLD

GRISWOLD discloses a license management system and method for recording the use of licensed product, and for controlling its use.

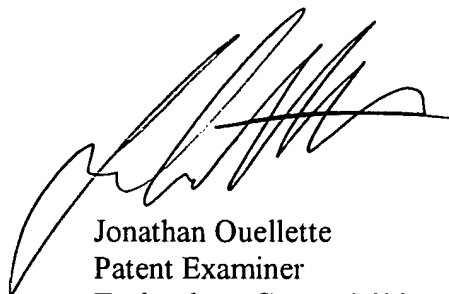
64. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**Van Kirk, Doug, "LAN software licensing", InfoWorld, v15n40, PP:
73-74, October 4, 1993.**

Van Kirk discloses several systems for license management.

65. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
66. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
67. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
68. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

September 14, 2005



Jonathan Ouellette
Patent Examiner
Technology Center 3600